

REMARKS

By this amendment, applicants have amended the claims to more clearly define their invention and to eliminate the improper multiple dependent claim format. In particular, claim 1 has been amended to eliminate the language deemed indefinite by the Examiner in the third paragraph on page 3 of the office action and to recite that the lacquer paint comprises a polymer-based lacquer. Claims 3 - 15 have been amended to eliminate the multiple dependent claim format, including the improper multiple dependent claim format in claims 4 - 15. Applicants have also added claims 15 - 19 to define further aspects of the present invention and have canceled claims 2, 13 and 14 without prejudice or disclaimer. Claim 1 has been amended to recite the material of which the conductive additives is made, i.e., being at least one additive selected from the group consisting of soots having conductivity, metal powders, conductively coated mica flakes, fine-particle SnO_2 which is surface-treated or is not surface-treated, semiconductor-doped BaSO_4 and organic additives, the conductive additives not having a modifying agent coating thereon. See, e.g., original claim 2 and page 2, lines 24 - 32 of applicants' specification. As is clear from applicants' specification, in particular, the examples in applicants' specification, the conductive additives do not have a modifying agent coating thereon.

In view of the foregoing amendments, reconsideration and withdrawal of the objection to claims 4 - 15 under 37 CFR 1.75(c) as being improper multiple dependent claims are requested.

In view of the foregoing amendments to the claims, especially the amendments to claim 1, it is submitted all of the claims now in the application comply with the requirements of 35 USC 112, second paragraph. Therefore, reconsideration

and withdrawal of the rejection of claims 1 - 3 under 35 USC 112, second paragraph, are requested.

Claims 1 - 3 stand rejected under 35 USC 102(b), (e) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over United States Patent No. 6,409,815 to Hennemann et al, United States Patent No. 5,071,593 to Takahashi et al or United States Patent No. 5,037,581 to Saitoh et al. Applicants traverse this rejection and request reconsideration thereof.

The pigments described in US Patent 6,409,815 B1 (Hennemann et al.) differ quite significantly from the conductive additives of the present invention. While the conductive pigments according to Hennemann et al. are partially coated with silanes, among other elements, the conductive additives according to the invention are not provided with such coatings.

Although the conductive additives according to the present invention can be conductive coated materials – materials that are also referred to be Hennemann et al these coated materials must be additionally partially coated with silanes or the like in Henneman et al. In Hennemann et al, these are thus double-coated materials.

The difference between the lacquer paint according to the invention and the coatings of the Takahashi et al. and Saitoh et al. documents is that the coatings in these documents are not lacquers. Takahashi et al. state: "When the layer of the conductive agent is thus formed in the plastic molding, a firm coating film can be formed thereon by an ordinary electrostatic coating method to obtain the product having quite excellent appearance and surface profile." (column 4, lines 61 to 65). Takahashi et al. describe the very method that is to be avoided with the solution according to the invention: the material is primed before it can be provided with a coating layer. The solution according to the invention avoids priming. The material

can be directly provided with the coating layer/lacquer layer according to the invention. Saitoh et al. state: "The term 'coating material' herein referred to includes paints, varnishes, enamels, or the like of aqueous synthetic resin coating materials, oil paints, varnishes, enamels or the like of aqueous synthetic resin coating materials, oil based synthetic resin coating materials and emulsion type coating materials (column 3, lines 19 to 23). "Lacquers" are clearly not mentioned. That is, the documents do not disclose a lacquer paint comprising a polymer-based lacquer.

For the foregoing reasons, none of Hennemann, et al, Takahashi et al and Saitoh et al disclose or would have suggested the presently claimed invention.

In response to the Examiner's comments concerning the international search report, applicants are submitting herewith a form PTO-1449 listing the documents cited in the search report. It is requested that the Examiner indicate these documents to have been considered.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance of all of the claims now in the application are requested.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 306.38504X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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Attachments